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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Raju Kucherlapati, et al.

Serial No.: 08/234,145 Group Art Unit: 1804

Filed: 28 April 1994 Examiner: S. Ziska

For: GENERATION OF XENOGENEIC ANTIBODIES Attorney Docket No.: 7639-033-999

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

Responsive to the Restriction Requirement mailed September 21, 1995 (Paper No. 10), Applicants elect the invention of Group IV with traverse.

The Examiner stated that inventions of Groups I and III and the invention of Group IV are related as process of making and product made by the process. The Examiner has asserted that the invention of Group IV is patentably distinct from the inventions of Groups I and III because the product of the invention of Group IV can be made by either the process of the invention of Group I or the process of the invention of Group III. The Examiner has stated that these two processes are materially different from one another, but has not explained how she has reached this conclusion. Accordingly, the Examiner has not met her burden in establishing that the claims are drawn to separate and distinct inventions. Furthermore, the Restriction Requirement between Groups III and IV should be withdrawn in view of the amendment to Claim 4

EXPRESS MAIL CERTIFICATION

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filed herewith. The amendment to Claim 4 makes the claims dependent on Claim 3, not Claims 1 and 3 together. Accordingly, the Restriction Requirement between the inventions of Groups III and IV is improper and must be withdrawn.

The Examiner has stated that inventions of Groups II and III are related as product and process of use. Specifically, the Examiner has stated that the product of the invention of Group II can be used in a process materially different from the process of the invention of Group III. Specifically, the Examiner has stated that the immortalized non-human cell line of Claim 2 (Group II) can be used in a materially different process, i.e., propagation of the cell line. The Examiner has not explained how the propagation of a cell line is materially different use than that of the method recited in Claim 3 (Group III). Group III recites the step of culturing the cells of Claim 2. It is unclear as to why the propagation of the cells recited in Claim 2 is materially different from the culturing of the cells of Claim 2 (as recited in a step in Claim 3). Accordingly, the Examiner has not met her burden in establishing that the claims are drawn to a separate and distinct invention. Therefore, the Restriction Requirement is improper and should be withdrawn.

The Examiner stated that the invention of Group V is drawn to a method for producing a modified non-human animal and that this method does not require the material methods of any of the other invention groups. As the Examiner has not given a reason as to why Invention V is a separate and distinct invention, the Restriction Requirement is improper and should be withdrawn.

In making the above traversal of the Restriction Requirement, the Applicants are not asserting that inventions of Groups I, II, III, IV and V are obvious over one another. Instead, Applicants are arguing that the Examiner has not met her burden in establishing the Restriction Requirement.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned

at (415) 854-3660. The Commissioners are authorized to charge any underpayment or credit any overpayment to the deposit account No. 16-1150 for any matter in connection with this response, including any fee for extension of time which may be required.

Respectfully submitted,

PENNIE & EDMONDS

Dated: 11/21/95

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Enclosure